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09/804,074	03/13/2001	Stephen Johnson	4546-002	9099

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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/804,074	JOHNSON ET AL.	
	Examiner	Art Unit	
	Mohammad A. Siddiqi	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04/26/2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1-58 are presented for examination.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/26/2005 has been entered.

***Response to Declaration Under 37 C.F.R. 1.132***

3. The declaration under 37 CFR 1.132 filed 04/07/2005 is insufficient to overcome the rejection of claims 1, 17, 23, 41, and 53 based upon the rejection as set forth in the last Office action because:

In response to affiant's argument towards "Scripting language with in browser" not explicitly present in claims except claims 39, 40, 43, 44, and 55. No argument has been presented that scripting

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language is inherently part of the browser, so not sufficient to be applicable to claims 10 and 32.

More specifically the affiant's argues that the collaboration between the client parties is being facilitated using client-to-client or peer-to-peer communication (fig 3). Client-to-client or peer-to-peer neither presented in independent claims 1, 17, 23, 41, and 53 nor recited in claims 39, 40, 43,44, and 55. Furthermore, the arguments seem to be contradictory to the scope of the claimed invention as evident by claims 14 and 15. The Examiner takes note the above Affiant's remarks; however, Affiant's remark could not be imported into the claim. Therefore, the declaration is not persuasive.

### ***Response to Arguments***

4. Applicant's arguments filed 04/07/2005 have been fully considered but they are not persuasive, therefore, the rejections to claims 1-58 are maintained.

5. Applicants argued in the remarks:

**Argument:** Claims 1 and 23, Eintracht does not teach client-to-client transmission.

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**Response:** Claim language "transmitting a message having said rendering instruction embedded therein and comprising said collaborative content between client workstations" not clearly and concisely claims client-to-client or peer-to-peer (in spec peer-to-peer stated fig 3). "collaborative content between client workstations" not defined in specification, applicant can be it's own lexicographer (Inre Fine), but Client-to-client nebulous term cannot be defined during prosecution.

6. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

7. Applicant's argument has been addressed in the previous office action mailed on 02/10/2005. The newly amended limitations are rejected and disclosed below:

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Eintracht et al. (96,687,878) (hereinafter Eintracht).

9. As per claims 1 and 23, Eintracht discloses a computer-implemented method of network collaboration through embedded annotation (URL associated with the document, col 4, lines 13-25) and rendering instructions to generate, transmit, and render collaborative content, the method comprising the steps (fig 1C, col 2, lines 1-27; lines 41-46; lines 56-65) of:

generating a collaborative content including a base document and at least one collaborative content element (col 2, lines 40-46) having at least one annotation embedded therein, and rendering instruction therefor (associated term is anticipates embedded in the context of the invention, for example URL associated with the document anticipates embedded in the document, col 2, lines 8-11; col 4, lines 13-25);

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rendering said collaborative content (col 2, lines 8-55) in accordance with rendering instruction (captures special request, col 2, lines 21—27); and

transmitting a message having said rendering instruction (col 2, lines 41-46) embedded therein and comprising said collaborative content between client workstations (clients can annotate same document, col 2, lines 41-55; lines 56-67, e-mail).

10. As per claims 2 and 24, Eintracht discloses further comprising the steps of: annotating said collaborative content by adding another collaborative content element (any new notes that any other clients may have posted, col 2, lines 41-46).

11. As per claims 3 and 25, Eintracht discloses wherein said annotating step comprises presenting annotation options to said client workstation (client, col 2, lines 41-46).

12. As per claims 4 and 26, Eintracht discloses wherein said annotating step comprises inputting a text element to name said collaborative content element (col 15, lines 10-14).

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13. As per claims 5 and 27, Eintracht discloses wherein said annotating steps comprises inputting a text input element to generate text as said collaborative element (col 15, lines 10-20).

14. As per claims 6 and 28, Eintracht discloses wherein said annotating steps comprises providing a visual cue to indicate the state of said collaborative content (col 2, lines 65-67).

15. As per claims 7 and 29, Eintracht discloses wherein said visual cue comprises at least one of a marker, cursor, icon, and marquee box (col 7, lines 1-17).

16. As per claims 8 and 30, Eintracht discloses wherein said transmitting step is initiated by a user selecting a visual element to transmit said collaborative content (col 2, lines 47-67, col 3, lines 1-4).

17. As per claims 9 and 31, Eintracht discloses wherein said client workstation includes at least one of a personal computer equipped with internet browser software, a mobile communication device with a graphical or textual display, and a personal digital assistant equipped with a hypertext viewer (col 2, lines 34-40).



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18. As per claims 10 and 32, Eintracht discloses wherein said client workstation includes a program execution capability comprising: an interpreted software program (Java, col 9, lines 26-32); a compiled software program (Java, col 9, lines 26-32); and a software program executed by a virtual machine (Java, col 9, lines 26-32).

19. As per claims 11 and 33, Eintracht discloses wherein said transmitting step is performed using a messaging system (fig 3, col 7, lines 24-52).

20. As per claims 12 and 34, Eintracht discloses wherein said messaging system includes at least one of:  
an electronic mail system (fig 3, col 7, lines 24-52); an electronic news or bulletin-board system (members of the group, col 1, lines 26-36); and a mobile paging system (messaging system, fig 3, col 7, lines 24-52).

21. As per claims 13 and 35, Eintracht discloses wherein said transmitting step is performed using a transport mechanism including at least one of:

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an internet protocol (col 9, lines 24-60, col 10, lines 28-39);

a wireless protocol (URL, col 9, lines 24-60, col 10, lines 28-39);

a synchronous messaging protocol (URL, col 9, lines 24-60, col 10, lines 28-39, col 2, lines 9-67); and

an asynchronous messaging protocol (URL, col 9, lines 24-60, col 10, lines 28-39, col 2, lines 9-67):

22. As per claims 14 and 36, Eintracht discloses wherein said rendering step is performed on a client workstation (col 2, lines 41-46).

15. As per claims 15 and 37, Eintracht discloses wherein said rendering step is performed on a server (col 2, lines 56-67).

23. As per claim 16, Eintracht discloses wherein the collaborative content transmitted in said transmitting step includes a URL and rendering instructions (col 4, lines 53-58).

24. As per claim 38, Eintracht discloses the collaborative content transmitted includes a URL comprising the embedded annotation and rendering instructions (associated term is anticipates embedded in the context of the invention, for example URL associated with the

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document anticipates embedded in the document, col 2, lines 8-11; col 4, lines 13-25).

25. As per claim 39, Eintracht discloses wherein said sequences of instructions include at least one of a client-side scripting language (page description language, col 6, lines 31—54).

26. As per claim 40, Eintracht discloses wherein said sequences of instructions include at least one of Javascript and dynamic HTML (page description language, col 6, lines 31-54, col, col 9, line 28-30).

27. As per claim 17, Eintracht discloses a network collaboration tool using embedded annotation and rendering instructions comprising:

a web browser software for displaying a collaborative content (browser, col 2, lines 47-49) in accordance with rendering instructions therefor, said collaborative content including a base document (collaborative document, col 2, lines 9-11) and at least one collaborative content element having an embedded annotation (associated term is anticipates embedded in the context of the invention, for example URL associated with the document anticipates embedded in the document, col 2, lines 8-11; col 4, lines 13-25);

a graphical collaboration tool (browser, col 7, lines 24-30) for

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generating at least one collaborative content element on the collaborative content displayed in said web browser software and transmitting the at least one collaborative content element (fig 2-3, col 2, lines 16-27, col 7, lines 24-44) and rendering instructions therefor (server side functions, col 2, lines 22-27);

and a server process for receiving (col 2, lines 21-26) the at least one generated collaborative content element and instruction therefor, rendering the collaborative content in combination with the received collaborative content element in accordance with the received rendering instructions (col 2, lines 17-27), and generating a combined collaborative content including the received collaborative content element and embedded annotation ( associated term is anticipates embedded in the context of the invention, for example URL associated with the document anticipates embedded in the document, col 2, lines 8-11; col 4, lines 13-25) thereof for display by said web browser software (fig 2-3, col 2, lines 9-67, col 7, lines 24-44).

28. As per claim 18, Eintracht discloses wherein said graphical collaboration tool includes a toolbar (col 7, lines 24-44).

29. As per claim 19, Eintracht discloses wherein said toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add

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text tool, and an add text highlight tool (col 7, lines 24-44, col 17, lines 45-55).

30. As per claim 20, Eintracht discloses wherein said graphical collaboration tool includes a collaborative content element name entry field (col 7, lines 24-44, col 17, lines 18-67).

31. As per claim 21, Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process execute on the same computer system (col 7, lines 24-35).

32. As per claim 22, Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system (fig 2-3, col 7, lines 24 – 51).

33. As per claim 41, the claim is rejected for the same reasons as claim 17, above. In addition, graphical collaboration tool is downloaded from a server (plug-in, fig 3, col 7, lines 24-43).

34. As per claim 42, Eintracht discloses wherein said collaborative content is referencable by a URL (col 4, lines 13-37).

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35. As per claim 43, Eintracht discloses wherein said graphical collaboration tool includes a client-side scripting language (page description language, col 6, lines 31-54).

36. As per claim 44, Eintracht discloses wherein said graphical collaboration tool includes at least one of Javascript and dynamic HTML (page description language, col 6, lines 31-54).

37. As per claim 45, Eintracht discloses wherein said collaborative content includes a URL of the base document and a representation of the collaborative content element (fig 5, col 4, lines 13-38).

38. As per claim 46, Eintracht discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to add a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the added collaborative content element (see abstract, fig 5, col, lines 31-54).

39. As per claim 47, Eintracht discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical

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collaboration tool to modify a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the modified collaborative content element (see abstract, fig 5, col 6, lines 31-54).

40. As per claim 48, Eintracht discloses wherein said graphical collaboration tool includes a toolbar (Graphical user interface, col 6, lines 31-54).

41. As per claim 49, Eintracht discloses wherein the toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (col 17, lines 45-64).

42. As per claim 50, Eintracht discloses wherein the toolbar includes a collaborative content element name entry field (col 17, lines 17-19).

43. As per claim 51, Eintracht discloses wherein said collaborative content received from the server includes an HTML page (col 6, lines 31-54, col 5, line 40).

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44. As per claim 52, Eintracht discloses wherein said collaborative content received from the server includes an HTML page (col 6, lines 31-54, col 5, line 40).

45. As per claim 53, the claim is rejected for the same reasons as claim 17, above.

46. As per claim 54, Eintracht discloses wherein said collaborative content is referencable by a URL (col 4, lines 13-37).

47. As per claim 55, Eintracht discloses wherein said server process is a CGI script (col 30, lines 31-54).

48. As per claim 56, Eintracht discloses wherein said collaborative content includes a URL of a base document and a representation of a collaborative content element (col 4, lines 13-37).

49. As per claim 57, Eintracht discloses wherein said server process executes on a client workstation of a user (col 2, lines 34-67).



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50. As per claim 58, Eintracht discloses wherein said collaborative content transmitted in response to a user request includes an HTML page (col 6, lines 31-54, col 5, line 40).

51.

### ***Conclusion***

52. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Patent 6,360,236

U.S. Patent 6,342,906

U.S Patent 6,018,738

U.S patent 6,640,241

U.S. Patent 6,549,944

U.S. Pub 2001/0016872

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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